

REMARKS

The final Office action of 26 October 2009 (Paper No. 20091022) has been carefully considered. Allowance of claim 76 is noted with appreciation.

Status of the Claims

Claims 54 through 64 and 71 through 76 are pending, of which claims 54 through 64 and 71 through 75 are rejected. Claim 76 is allowed.

Listing of the Claims

Pursuant to 37 CFR §1.121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

Amendment of the Claims

The claims are not amended.

Allowable Subject Matter

The allowance of Claim 76 over the prior art of record, is noted with appreciation.

Rejection of Claims 59-64 On Obviousness-Type Double Patenting

Claims 59 through 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19 through 21, 23, 24, 28, and 39 of U.S. Patent No. 6,820,616 B1. In support of this rejection, Paper No. 20091022 stated that,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 59 has everything as recited in the patented claim 21 including a controller. The only difference is the recitation of a control panel with a “mode selection switch.” However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control panel to US’616’s controller so that the user can

adjust the settings via the switches. Note that the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21), it is considered that the controller is coupled to all the units and the common gas system for providing the controlling function. The limitation of control panel is also found in the patented claim 39. In addition, having a switch in a control panel is a well-known feature for controlling a system. The limitation of a switch is also found in the patented claim 39. Thus, any infringement over the patent would also infringe on the instant claims.

The limitations of claim 60 can be found in patented claim 20 (again it would have been obvious to include a control panel with a mode selection switch for the device with four testing units instead of three). The limitations of claim 61 can be found in patented claim 21. The limitations of claim 62 can be found in patented claim 23. The limitations of claim 63 can be found in patented claim 24. The limitations of claim 64 can be found in patented claim 28.”

This rejection is factually erroneous, and is illegal under 35 U.S.C. §121, as may be understood by the following explanation.

In support of this objection, and the accompanying rejection of claim 59, the Examiner has previously asserted that,

“Applicant’s claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and 365(c) as follows:

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120 and 365, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be

included in the first sentence(s) of the specification following the title or in an application data sheet.

For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application.”

Appellant respectfully notes that neither 37 CFR §1.78(a) nor 37 CFR §1.78(d) impose these requirements; moreover, there is absolutely not one word written by the U.S. Congress in 35 U.S.C. §121 that purports to limit Appellant’s ability to seek examination of non-elected claims as a consequence of the Examining staff’s imposition of a requirement under 35 U.S.C. §121. This objection, and the accompanying rejection of claim 59, are improper. Their withdrawal is respectfully urged.

A. **The Examining staff is granted no authority under 35 U.S.C. §121 to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting, when the applied art is “[a] patent issuing upon an application with respect to which a requirement for restriction under the section has been made,” and the claim is pending in a divisional “application filed as a result of the requirement ... before the issuance of the patent on the other application.”**

Claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 19 through 21, 23, 24, 28 and 39 of Appellant’s U.S. Patent No. 6,820,616 B1. In support of this rejection, the Examining staff previously argued that,

“The limitation of a control panel with respect to Applicant’s arguments against the double patenting rejection of claim 1, it is respectfully submitted that ... that applicant has been clearly shown

the similarities in the corresponding claims.”

Now, Paper No. 20070914 argues in an un-numbered paragraph, that,

“the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as recited in the patented claim 21** including a controller. *The only difference is ... a control panel.* ... The limitation of a control panel is also found in the patented claim 39”

What the Examiner has improperly ignored however, is that Appellant’s *Application Data Sheet 37 CFR 1.76* expressly claims, under the *Domestic Benefit/National Stage Information*, is in the express language of Appellant’s *Application Data Sheet 37 CFR 1.76*, that accompanied the filing of Appellant’s above-captioned application, is a:

Division application of [Appellant’s] Prior Application Number 10208188 filing Date 2002-07-31 Patent Number 6820616 Issue Date 2004-11-23.”

In the precise language and format of the Appellant’s *Application Data Sheet 37 CFR 1.76*,

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.

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Under the statute however,

“A patent issuing upon an application with respect to which a requirement for restriction under the section has been made, or on an application filed as a result of the requirement, shall not be used as a reference either in the Patent and Trademark Office ... against a divisional application or against the original application or on any patent issued on either of them if the divisional application is filed before the issuance of the patent on the other application.”¹

In other words, the above-captioned application (a) is a divisional application of U.S. Patent No. 6,820,616, and (b) was timely filed on the 11th of March 2005 during (c) the co-pendency of Appellant’s PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)*, which had been filed under Title 35 U.S. Code §365(c) on the 17th of July 2003 and duly assigned Serial No. PCT/US03/19560, as was claimed in Appellant’s original specification,

This application also makes reference to, incorporates the same herein, and claims all benefits accruing under 35 U.S.C. §119 from a provisional application entitled *Combined Aircrew Systems Tester (CAST)* filed in the United States Patent & Trademark Office on 1 August 2001, and there duly assigned Serial No. 60/308,846 and my U.S. patent application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)* filed in the United States Patent & Trademark Office on 31 July 2002, and there duly assigned Serial No. 10/208,188 by that Office, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004. This application further makes reference to, incorporates the same herein, and claims all benefits accruing under Title 35 U.S. Code §365(c) of my PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)*, filed on 17 July 2003 and duly assigned Serial No. PCT/US03/19560.

Or, in the language of the now amended specification,

This application is filed pursuant to 35 U.S.C. §121 as a Divisional of Applicant’s Patent Application Serial No. 10/208,188 filed in the U.S. Patent & Trademark Office on the 31st of July 2002, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004. and

¹ 35 U.S.C. §121.

assigned to the assignee of the present invention. All benefits accruing under 35 U.S.C. §120 from the parent application are also hereby claimed. This application also makes reference to, incorporates the same herein, and claims all benefits accruing under 35 U.S.C. §119 from a provisional application entitled *Combined Aircrew Systems Tester (CAST)* filed in the United States Patent & Trademark Office on 1 August 2001, and there duly assigned Serial No. 60/308,846 and my U.S. patent application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)* filed in the United States Patent & Trademark Office on 31 July 2002, and there duly assigned Serial No. 10/208,188 by that Office, which is now issued as U.S. Patent No. 6,820,616 on 23 November 2004. This application [[also]] further makes reference to, incorporates the same herein, and claims all benefits accruing under Title 35 U.S. Code §365(c) of my PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)*, filed on 17 July 2003 and duly assigned Serial No. PCT/US03/19560.

prior to the issue date of Appellant's Serial No. PCT/US03/19560. The instant, above-captioned U.S. application Serial No. 10/522.721 is a continuation of Appellant's U.S. Patent No. 6,588,243, and a divisional application of Appellant's U.S. Patent No. 6,820,616. Even the fact that such a requirement for a restriction may have been belatedly withdrawn in a subsequent Office action due to the Examiner's delayed recognition that all of the independent claims were allowable over the prior art is immaterial under the language of 35 U.S.C. §121, because Appellant had already been subjected by the Examiner to the inconvenience, delay in obtaining an issue date and the unnecessary expense concomitant to a requirement imposed under 35 U.S.C. §121. Nothing in 35 U.S.C. §121 negates the prohibition that the parent application "shall not be used as a reference either in the Patent and Trademark Office ... against a divisional application ... if the divisional application is filed before the issuance of the patent on the other application"² even after the Examiner purports during the course of the conclusion of the examination, to have withdrawn a requirement earlier imposed under 35 U.S.C. §121; Appellant notes that when the Examiner examines the application on the basis of the Appellant's election prior to purporting to withdraw a requirement for election of species, but does not expressly accord the Appellant an opportunity to add claims directed to all of the non-

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35 U.S.C. §121.

elected species, the “withdrawal” is in name only, and is illusory because Appellant has been denied the opportunity to present claims specifically directed to the non-elected species to the exclusion of the elected species.

This rejection is therefore, contrary to law, because the sole requirement imposed by the foregoing excerpt of 35 U.S.C. §121 has been met, namely the filing on the 11th of March 2005 of Appellant’s above-captioned application during the co-pendency of Appellant’s PCT International application entitled *COMBINED AIRCREW SYSTEMS TESTER (CAST)*, filed under Title 35 U.S. Code §365(c) on the 17th of July 2003 and duly assigned Serial No. PCT/US03/19560, as was claimed in Appellant’s original specification

Absent Congressional action to modify 35 U.S.C. §121, neither the Director nor any member of the Examining staff has the authority to belatedly overrule the action taken by the Office in imposing a requirement for restriction under 37 CFR §1.142. This rejection is therefore, not sustainable on the evidence of record.

Applicant notes that this rejection gives no consideration to either the *O.G.* page or Applicant’s immediate parent, U.S. Patent No. 7,270,125 B1 issued on the 18th of September 2007, as a “Division of application No. 10/208,188, filed on Jul 31, 2002, now Pat. No. 6,820,616,” or to the accompanying *Data Sheet* of Applicant’s immediate parent. This failure is evidence of the lack of completeness in Paper No. 20091022 under 37 CFR §1.104(a) and (b). Correction of this omission, and reconsideration are respectfully requested.

B. 35 U.S.C. §121 mandates an absolute prohibition (*e.g., shall not be used as a reference ... against a divisional application*) of citation of Appellant’s parent application to support any type of rejection of any claim in this divisional application.

Claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 19 through 21, 23, 24, 28 and 39 of Appellant’s U.S. Patent No. 6,820,616 B1. In support of this rejection, the Examining staff previously argued that,

“The limitation of a control panel with respect to Appellant’s arguments against the double patenting rejection of claim 1, it is

respectfully submitted that ... that Appellant has been clearly shown the similarities in the corresponding claims.”

Now, Paper Nos. 20070914 and 20091022 argue that,

“the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as recited in the patented claim 21** including a controller. *The only difference is ... a control panel.* ... The limitation of a control panel is also found in the patented claim 39”

What the Examiner has improperly ignored however, is that Appellant’s *Application Data Sheet 37 CFR 1.76* expressly claims, under the *Domestic Benefit/National State Information*, using the express language of Appellant’s *Application Data Sheet 37 CFR 1.76* which accompanied the filing of Appellant’s above-captioned application, and which has today been re-filed, is sufficient to invoke the absolute prohibition (*e.g., shall not be used as a reference ... against a divisional application*) of 35 U.S.C. §121 against citation of Appellant’s parent application to support any type of rejection of any claim in this divisional application.

Moreover, 37 CFR 1.76 is nowhere declared to constitute the sole and exclusive mechanism for an applicant to make a claim as a divisional application. Here, the requirement imposed under 35 U.S.C. §121 and 37 CFR §1.142 remains and was never withdrawn while examination of Applicant’s parent applications was open. Consequently, this rejection is therefore illegal under 35 U.S.C. §121. Withdrawal of this rejection however, is respectfully urged.

C. The prohibition of the third sentence of 35 U.S.C. §121 is not limited by the style of the claims in the cited patent, or application, and in the divisional application.

Claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting. The third sentence of 35 U.S.C. §121 applies that prohibition against the patent, or application itself, and that prohibition is not limited by either the style, format or even the content of the claims in the divisional application. Moreover, what the Examiner appears to have ignored here is that a requirement for restriction is imposed on the basis of **subject matter**, not upon the claims, because

the claims define neither a Group in a requirement for restriction or a Genius or Species in a requirement for an election of species.

As was explained by the Federal Circuit in *TiVo, Inc. v. Echostar Communications Corporation, et al.*, “hardware claims” may be written in both a “process” style (e.g. claim 1 in *TiVo*) and in an “apparatus” style (e.g. claim 32 in *TiVo*). Consequently, the claims presented in a divisional application that are directed to the **non-elected subject matter** of Group II defined in Paper No. 4 may be written either in an “apparatus” style or in a “process” style.

Claims 59 through 64 define the cooperative relation between the “control panel” and Appellant’s “first unit”, “second unit”, “third unit”, “common gas system”, “mode select switch” and the “first compressor” and the “second compressor.” The particular operational relationships between the structural features of claim 59 define the “method of operating a gas system and method of testing” of non-elected Group II (e.g., “compressing the air when the pressure ... is below ...” and “compressing the air when the pressure ... is equal to ...”) of Paper No. 4. Consequently, the prohibition of 35 U.S.C. §121 prohibits the citation of the parent to which the requirement for restriction was applied, to support a double patenting rejection of claims 59 through 64 in the instant divisional application. The Examiner is accordingly urged to refuse to maintain this rejection.

D. Paper No. 20070914 fails to make a *prima facie* demonstration of obviousness of claim 59 over claims 21 and 39 of Appellant’s parent application.

Appellant again notes that claim 59 is rejected under the doctrine of non-statutory, obviousness-type double patenting over claims 21 and 39 of Appellant’s U.S. Patent No. 6.820.616 B1. In support of this rejection, the Examining staff previously argued that,

“The limitation of a control panel with respect to Appellant’s arguments against the double patenting rejection of claim 1, it is respectfully submitted that ... that Appellant has been clearly shown the similarities in the corresponding claims.”

Now, Paper No. 20070914 argues in an un-numbered paragraph, that,

“the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 has everything as recited in the patented claim 21 including a controller. *The only difference is ... a control panel ...*. The limitation of a control panel is also found in the patented claim 39 ...”

This assertion of Paper No. 20070914 is factually erroneous on the record before the Board. The “control panel” is not a single, off-the-shelf item, and there is no evidence of record which would suggest that the “control panel” defined by rejected claim 59 is, in the sense of *KSR International*, an off-the-shelf item known to have been previously used as defined by claim 59.

Moreover, what the Examiner has improperly ignored however, is that claim 59 defines a structure that is patentably distinguishable from patent claim 21. The underlying assertion of the Examining staff that “*The only difference is ... a control panel ...*” is erroneous. Contrary to the Examiner’s assertion, other differences do in fact exist because claim 21 defines a structure which incorporates, *inter alia*, flow sensors and pressure sensors, and pressure valves. This structure is not defined by claim 59.

Claim 59 however, defines a “control panel” and the cooperative relation between the “control panel” and Appellant’s “first unit”, “second unit”, “third unit”, “common gas system”, “mode select switch” and the “first compressor” and the “second compressor.” This structure is nowhere defined by either patent claim 21 nor its parent claim 19. Moreover, claim 21 does not encompass Appellant’s “mode select switch.” Furthermore, this cooperative relationship between these structural features of claim 59 is not found in patent claim 21. Consequently, the assertion of the Examining staff that “*The only difference is ... a control panel ...*”, is incorrect and false.

Claim 39, which does define a “control panel” and its operational structure, does not depend upon patent claim 21. Moreover, claim 39 does not encompass Appellant’s “mode select switch” defined by claim 59. Consequently, the assertion of the Examining staff that “The limitation of a control panel is also found in the patented claim 39 ...”, is incorrect and false.

In order to make a *prima facie* demonstration of obviousness under 35 U.S.C. §103(a), “all the elements of” the pending claims must be “accounted for in the prior art relied upon in this record.”³ Even ignoring *arguendo* the impropriety of the citation of Appellant’s parent application against a claim in this divisional application, patent claim 21 does not encompass Appellant’s “mode select switch” set forth in rejected claim 59. These differences may not be ignored in a determination of obviousness *vel non*. Moreover, claim 59 is not a claim that defines “a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field” as was found in *KSR Int'l Co., v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1391 (2007), but a claim that defines a single structure that may be used advantageously to test all the aircrew’s life support equipment. As explained in Appellant’s originally filed specification, embodiments defined by claim 59 do not require anything more than commonly available local power to operate, and defines a structure that could be used in operation in a chemical environment. Embodiments of claim 59 do not require a separate high-pressure source of breathing air or oxygen, and have the ability to significantly reduce supporting man-hours, deployment costs and mobility footprint when testing related units of a mask, suit and the associated communication system for a single unit of an aircrew system.

Neither is claim 59 governed by *Perricone v. Medicis Pharmaceutical*, 77 USPQ2d 1321, 1324-25 (Fed. Cir. 2005) where the Court of Appeals upheld a finding of invalidity of certain claims based upon double patenting and a determination that both of the plaintiff’s patents disclosed essentially the same subject matter, because in *Perricone*, no requirement for restriction was ever issued by the Office under 35 U.S.C. §121. Here, claim 59, although written in apparatus format, is directed to the subject matter of non-elected Group II, namely the operational aspects of a gas system and a method of testing. The prohibition of the third sentence of 35 U.S.C. §121 is directed to the citation of one “application”, or “patent”, against another “application”, or “patent”, and not as is suggested by the Examiner here, to the style (*e.g.*, method or apparatus) of the claims in the application. The Board is respectfully urged to refuse to sustain this rejection.

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In re John B. Sullivan, et al., ____ F.3d ___, ____ U.S.P.Q.2d ____ (Fed. Cir. 2007)(citation still unavailable).

Conclusion

The Court of Appeals carefully explained in its decision for *TiVo, Inc. v. Echostar Communications Corporation, et al.*, that “hardware claims” may be written in both a “process” style (e.g. claim 1 in *TiVo*) and in an “apparatus” style (e.g. claim 32 in *TiVo*). Similarly, claims directed to the particular process identified in Group II in Paper No. 4 issued on the 21st of May 2003 in Appellant’s parent application, are not restricted to solely the “method” format, because the third sentence of 35 U.S.C. §121 speaks of “patents” and “applications” rather than “claims” or of “methods”, “apparatus”, “machine”, “manufacture” or even “composition of matter.” Rather, the question is one of “invention” as is expressly stated in the second sentence of 35 U.S.C. §121, and as has been noted in *TiVo*, an invention may be defined in the format of either “apparatus” or “process.” Consequently, an obviousness type double patenting rejection may not be grounded upon the format or style of a claim.

Moreover, the claims presented in a divisional application that are directed to the non-elected subject matter of Group II defined in Paper No. 4 may be written either in an “apparatus” style or in a “process” style. Claim 59 is drawn to the subject matter of non-elected Group II, and defines the process of regulating the operational relationships between the structural features of claim 59, a “method of operating a gas system and method of testing” of non-elected Group II (e.g., “compressing the air when the pressure ... is below ...” and “compressing the air when the pressure ... is equal to ...”) set forth in Paper No. 4. Consequently, the prohibition of 35 U.S.C. §121 prohibits the citation of the parent to which the requirement for restriction was applied, to support a double patenting rejection of claim 59.

The structure of rejected claim 59 is nowhere defined by either patent claim 21 nor its parent claim 19. Moreover, patent claim 21 does not encompass Appellant’s “mode select switch.” Furthermore, this cooperative relationship between these structural features of claim 59 is not found in patent claim 21. Consequently, two-way distinctiveness exists, and the patent claims fail to make a *prima facie* showing of obviousness. Consequently, the belated presented assertion by the Examiner in Paper No. 20070914 that:

“the conflicting claims are not identical, they are not patentably distinct from each other because ... claim 59 **has everything as**

recited in the patented claim 21 including a controller. *The only difference is ... a control panel.* ... The limitation of a control panel is also found in the patented claim 39”

is, on the administrative record before the Board, factually erroneous because there is a complete dearth of evidence in the administrative record which shows either the constituent components defined by Appellant’s “control panel” or Appellant’s “mode selection switch.” Additionally, the Examiner’s assertion about “patented claim 39” is factually incorrect, as is demonstrated by a comparison of patent claim 39 with Appellant’s rejected claim 59.

In view of these errors on the administrative record, the Examiner is respectfully urged to refuse to maintain this rejection of claims 59 through 64.

I. Claims 59 through 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19 through 21, 23, 24, 28 and 39 of Jordan, U.S. Patent No. 6,820,616 B1.

In support of this rejection, the Examiner asserted that,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 59 has everything as recited in the patented claim 21 including a controller. The only difference is the recitation of a control panel with a “mode selection switch.” However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a control panel to US’616’s controller so that the user can adjust the settings via the switches. Note that the controller controls the operation of the gas system, which comprises the first, second, and third units and the common gas system (see patented claim 21), it is considered that the controller is coupled to all the units and the common gas system for providing the controlling function.

The limitation of control panel is also found in the patented claim 39.

In addition, having a switch in a control panel is a well-known feature for controlling a system. The limitation of a switch is also found in the patented claim 39. Thus, any infringement over the patent would also infringe on the instant claims.

The limitations of claim 60 can be found in patented claim 20 (again it would have been obvious to include a control panel with a mode selection switch for the device with four testing units instead of three). The limitations of claim 61 can be found in patented claim 21. The limitations of claim 62 can be found in patented claim 23. The limitations of claim 63 can be found in patented claim 24. The limitations of claim 64 can be found in patented claim 28.”

Claims 59-64

This rationale of the factual evidence of record is misleading, and technically inaccurate because none of claims 19-21, 23, 24 or 28 of U.S. Patent No. 6,820,616 B1 define Applicant’s:

“a control panel coupled to each of the first unit, the second unit, the third unit, and the common gas system, the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor”

as is set forth in parent independent Claim 59. Only claim 39 of Applicant’s ‘616 defines a “control panel” defined as “having a plurality of switches and indicators *for controlling* the tests for said *first, second, third and fourth units*. Claim 39 is utterly devoid of any definition of either pending claim’s “the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor.”

Moreover, no limitation within claims 19-21, 23, 24, 28 or 39 of U.S. Patent No. 6,820,616 B1 define Applicant’s,

“a common gas system integrated into said first unit and said second unit, said common gas system characterized by a first compressor and

a second compressor producing a lower flow and a higher pressure than said first compressor, said first compressor compressing air when a pressure of an item to be tested is below a preset pressure value, and said second compressor compressing the air when the pressure of the item to be tested is equal to or over the preset pressure value.”

In view of this two-way distinctiveness, there is no factual evidence within this administrative record to support a conclusion at law of obviousness of parent independent claim 59, and its dependent claims 60 through 64. Withdrawal of this rejection is again respectfully urged.

Rejection of Claims 54-58 And 71-75 On Obviousness-Type Double Patenting

Claims 54-58 and 71-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 modified according to Sherrod (US 5,979,444 A). In support of this rejection, Paper No. 20091022 stated that,

“Although the conflicting claims are not identical, they are not, they are not patentably distinct from each other because for example, instant claim 54 has everything as recited in the patented claim 1 except the recitation of a “regulator enable valve.” However, regulator enable valves are well known and commonly used in the art. For example, Sherrod discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a regulator enable valve as taught by Sherrod and is well known in the art to US'616's system so that the pressure of air flowing through the regulator can be accurately controlled to provide breathable air at a safe pressure to a user.

The limitations of claim 55 can be found in patented claim 4.

The limitations of claim 56 can be found in patented claim 7. The limitations of claim 57 can be found in patented claim 9. The limitations of claim 58 can be found in patented claim 17. The limitations of claim 71 can be found in patented claims 26 and 27.

The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US'616's controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.”

Claims 54-58 and 71-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 in view of Sherrod (US 5,979,444 A).

The rationale given in Paper No 20090323 in support of this conclusion of law, is that,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, instant claim 54 has everything as recited in the patented claim 1 except the recitation of a “regulator enable valve.” However, regulator enable valves are well known and commonly used in the art. For example, Sherrod discloses a breathing apparatus with a regulator enable valve (22) coupled to a pressure regulator (90) to control the pressure of air flowing through the regulator. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a regulator enable valve as taught by Sherrod and is well known in the art to US'616's system so that the pressure of air flowing through the regulator can be accurately controlled to provide

breathable air at a safe pressure to a user.

The limitations of claim 55 can be found in patented claim 4. The limitations of claim 56 can be found in patented claim 7. The limitations of claim 57 can be found in patented claim 9. The limitations of claim 58 can be found in patented claim 17. The limitations of claim 71 can be found in patented claims 26 and 27.

The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US'616's controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.”

Applicant respectfully disagrees with this rationale.

Claims 54-58 and 71

This rationale is incomplete and is factually insufficient to support the Examiner’s conclusion at law of obviousness, because none of claims 1, 3, 4, 7, 9, 17, 21, 26, and 27 of U.S. Patent No. 6,820,616 B1 modified according to Sherrod US 5,979,444 A defines such features of claims 54 through 58 as Applicant’s:

“a first compressor compressing air, said first compressor coupled to each of the first system and the second system ...,”

“a second compressor compressing the air, said second compressor coupled to the second system,”

in combination with Applicant’s,

“a regulator enable valve coupled to the regulator, the regulator enable valve controlling pressure of air flowing through the regulator ...”

Modification of the primary reference to incorporate a “regulator” according to Sherrod ‘444 fails to remedy these deficiencies. Accordingly, there is no *prima facie* showing of obviousness-type double patenting.

Under the doctrine of obviousness-type double patenting, all differences between the claims must be identified before a conclusion at law of obviousness made be reached. This was not done in Paper No. 20090323. Consequently, the conclusion of obviousness is not supported by the facts introduced into the administrative record, and this rejection may not be maintained.

Claims 72-75

The rationale of Paper No 20090323 given as factual evidence in support of this rejection, states that:

“The limitations of claims 72, 73, and 75 can be found in patented claim 21. As discussed above, the addition of a regulator enable valve as taught by Sherrod would have been obvious to one of ordinary skill in the art at the time the invention was made as would have the addition of a control panel to US’616’s controller so that the user can adjust the mode settings via the switches (and accordingly the valves). The limitations of claim 74 can be found in claims 26 and 27.”

Applicant respectfully disagrees because the Examiner’s proposed combination of claims 21, 26 and 27 modified according to Sherrod ‘444 fails to define Applicant’s:

“control panel coupled to each of the first unit, the second unit, and the gas system, the control panel including a mode select switch for controlling flow of air compressed by the first compressor or the second compressor, the mode select switch turning on or off the first flow valve depending on a mode selected by the mode select switch.”

These differences were not identified or considered in Paper No. 20090323. Consequently, no *prima facie* showing of obviousness-type double patenting has been made from the facts placed into evidence in this administrative record, and this rejection may not be maintained. Its withdrawal is

respectfully requested. Such action is urged.

A. Authority to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting

Applicant continues to observe that the claims are prohibited under 35 U.S.C. §121 from being rejected by obviousness type double patenting because the instant application is a divisional application of the parent case US 6,820,616. The fact that once again, the Office has lost or misplaced documents, and that the Office has no record of an application data sheet (“ADA”) being submitted at the filing of the instant application. It is unclear where the ADA copied on page 26 of the appeal brief is located in the application record. The requirements for claiming benefit (i.e., either within the ADA or in the first sentence of the specification) are laid out in the final rejection of 9/27/2007. Accordingly, this application was not properly claimed as a divisional application within the required time period and as such, the claim for priority was not granted (i.e., there is no record of an ADA and the specification was not amended with the required four or sixteen month time period).

The Examiner’s assertion that “the Office will make a double patenting rejection because a patentee is entitled to only a single patent for an invention” has no basis at law where, as here, in imposing a requirement for restriction, the Office has declared that the application contains more than one independent and distinct invention.

Moreover, the form of a claim, whether method, apparatus, product-by-process or article of manufacture is simply a drafting technique that has no bearing upon the subject matter encompassed between two Groups identified in the requirement under 35 U.S.C. §121. The assertion by Paper No. 20090323 only the method claimed in instant claim 76 is prohibited from being rejected by the parent patent by 35 USC §121 because it is a separate and distinct invention from the patented apparatus” is nonsense, and has no authority in law.

Examiner’s Response to Arguments

Paper No. 20091022 stated that,

“Applicant’s arguments filed 10/2/2009 have been fully considered but they are not persuasive. Applicant presents no arguments that

significantly differ in scope from those presented previously.

Therefore, the response section from the previous rejection is substantially repeated here.

A. Authority to reject a claim filed in a divisional application under the doctrine of non-obviousness double patenting. In response to appellant's argument that the claims are prohibited from being rejected by obviousness type double patenting because the instant application is a divisional application of the parent case US 6,820,616, examiner respectfully notes that the Office has no record of an application data sheet ("ADA") being submitted at the filing of the instant application. It is unclear where the ADA copied on page 26 of the appeal brief is located in the application record. The requirements for claiming benefit (i.e., either within the ADA or in the first sentence of the specification) are laid out in the final rejection of 9/27/2007. Accordingly, this application was not properly claimed as a divisional application within the required time period and as such, the claim for priority was not granted (i.e., there is no record of an ADA and the specification was not amended with the required four or sixteen month time period). Therefore, the patent is not prohibited from being used in a double patenting rejection.

What is wrong with this assertion is that no authority supports the Examiner's conclusion of law that after imposition of final restriction against Applicant's parent applications, those parent applicaitons are "not prohibited [by 35 U.S.C. §121]from being used in a double patenting rejection."

What is also wrong is that Applicant has once again, today filed an *Application Data Sheet*, with authorization to charge the incurred fee. Refund of that fee is respectfully requested, because an *Application Data Sheet* was timely filed with Applicant's immediate parent application; that *Application Data Sheet* may not be ignored.

Paper No. 20091022 continues by asserting that,

"after review of the parent file wrapper, examiner sees no

indication that the requirement was clearly withdrawn.”

The Examiner’s clarification of this issue is noted with appreciation. Consequently, the “guidance given to examiners as set forth in the MPEP §804.01 (E), (F), and (G)” is in applicable here, and 35 USC §121 prohibits the **citation** of Applicant’s parent applications from being used in an obviousness type double patenting rejection.

Paper No. 20091022 also argued that,

“Additionally, if the restriction was not withdrawn, as noted in the MPEP §804.01, when an identical invention is claimed in both the patent and a pending application (as is the case here with the apparatus claims), “the Office will make a double patenting rejection because a patentee is entitled to only a single patent for an invention.” Here, the same device is being claimed in the patent and the instant application. The restriction requirement in the parent case was between an apparatus and a method of using that apparatus. The apparatus claims were elected, examined, and issued as a patent. Accordingly, only the method claimed in instant claim 76 is prohibited from being rejected by the parent patent by 35 USC §121 because it is a separate and distinct invention from the patented apparatus.”

Applicant respectfully submits that the factual situation found in MPEP §804.01, namely “when an identical invention is claimed in both the patent and a pending application,” is not the factual situation averred by Paper No. 20091022 to be present here. Consequently, MPEP §804.01 is inapplicable and should be ignored.

Paper No. 20091022 also stated that,

“B. 35 USC §121 does not mandate an absolute prohibition. As noted above, the Office has no record of an ADA and accordingly, the claim for priority was not timely submitted. However, even if the

instant case is considered a division of the patented case, the patent is still not barred from being used in an obviousness type double patenting rejection because the restriction requirement in the patent was between an apparatus and a method of using that apparatus. The apparatus was elected, examined, and issued as a patent. Accordingly, the Office will not grant two patents for the same invention and only the claimed method of operating the system is barred from an obviousness type double patenting rejection by the parent case.”

The foregoing assertion contradicts the admonition of the Commissioner written about 35 U.S.C. §121 (in all capital letters) in *MPEP* §803.01,

“IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.”

In other words, assuming that the unlikely should occur, namely the birth of an applicant who sought “two patents for the same invention,” the Commissioner’s admonition makes clear that there is nothing in 35 U.S.C. §121 that authorizes any member of the Examining Corps in the U.S. PTO to forbid the issuance of “two patents for the same invention.”

The Examiner is respectfully invited to ponder therefore, that in light of the Commissioner’s explicit caution, delivered in all capital letters in *MPEP* §803.01, that Paper No. 20091022 is mere Examiner’s argument devoid of authority of either 37 CFR or judicial decision. Consequently, the foregoing assertion is an improper conclusion of law unsupported by any factual evidence found in this administrative record. As such, this assertion has no merit and can not be relied upon to support this rejection.

Paper No. 20091022 continued by asserting that,

“C. Style of claims. As discussed above, the patent is not barred from being used in an obviousness type double patenting rejection because the restriction requirement in the patent was between an

apparatus and a method of using that apparatus. The apparatus was elected, examined, and issued as a patent. Accordingly, the Office will not grant two patents for the same invention and only the claimed method of operating the system is barred from an obviousness type double patenting rejection by the parent case.”

This assertion by Paper No. 20091022 is also mere Examiner’s argument devoid of authority of either 37 CFR or judicial decision. No factual evidence found in the administrative record supports the Examiner’s factual conclusion that,

“the restriction requirement in the patent was between an apparatus and a method of using that apparatus,”

or that,

“the patent is not barred from being used in an obviousness type double patenting rejection.”

The administrative record explicitly demonstrates that the requirement imposed in Paper No. 6 dated on the 12th of September 2003 was between Group I, “a gas system and a testing apparatus” and Group II, “a method of operating a gas system and a method of testing;” the finding of fact stated in Paper No. 6 was that Groups I and II were “distinct” and covered materially different subject matter. Consequently, the assertion by Paper No. 20091022 that this application and its parent are for “**the same invention**” is late and untimely, and is contradicted by the administrative record. Withdrawal of this rejection is again respectfully urged.

Paper No. 20091022 additionally asserts that,

“Appellant argues that the structure of the claims defines a “method of operating” and is merely a drafting technique. However, this is not convincing because the structural limitations of the instant claims are in the patented claims and any infringement over the patented system would clearly infringe on the instant application. The only claim defining a method of operating the gas system is instant claim 76, which has been indicated as allowable over the prior art of

record. The method of using a device falls into a different statutorily allowed category of invention.”

As was explained by the Federal Circuit in *TIVO*, assertions of statutorily different categories of invention is a myth, and provides no statutory basis for a rejection of these claims. Consequently, this assertion is an improper conclusion of law unsupported by any factual evidence found in this administrative record. As such, this assertion has no merit and can not be relied upon to support this rejection.

Paper No. 20091022 further asserted that,

“D. Prima Facie case of obviousness. Appellant argues that a control panel having a “mode selection switch” is not an obvious modification to the patented claims to one of ordinary skill in the art. However, this is not found convincing. “Panels” are well known and commonly used to hide/insulate electrical components from a user and the term “mode select switch” provides no definite structural limitation other than being a switch capable of controlling flow of air through the compressors. The patent claims a controller with switches for operation of the various tests of the system. Accordingly, examiner maintains that whether or not the patent specifically claims the switch as a “mode select switch” is not a patentable distinction because the patented switch controls the same various tests and structure as the instant claims and therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed the switches to control the flow of air through the compressors because this how the tests are performed in the patented claims as well as the instant claims. Additionally, it is obvious that a system with multiple testing units and a controller will need a means of switching between the various tests and controlling the individual components of the system. Similar arguments hold for

providing the system with a “regulator enable valve.” Such a modification would involve a mere use of a well known method into a well known device to yield predictable results that do not patentably distinguish an invention over the prior art.

Examiner again reiterates that these are obvious-type double patenting rejections because admittedly the claims are not identical, but any differences between the patented claims and the instant claims are clearly obvious variations.”

This assertion is based upon a finding that at the point-of-novelty, the “differences” between Applicant’s pending claims and the claims issued in Applicant’s parent application, a secondary reference teaches these “differences.” This assertion is improper under the doctrine of obviousness because Paper No. 20091022 fails to identify such a secondary reference, and because the Examiner is improperly focusing upon a “point-of-novelty” test and is improperly using Applicant’s own specification, rather than Applicant’s claims or a secondary reference, to teach the cooperative relationships between Applicant’s “regulator enable valve,” “controller,” and “switching” aspects

Withdrawal of this rejection is therefore respectfully urged.

CONCLUSION

Under the doctrine of non-statutory, obviousness-type double patenting. The third sentence of 35 U.S.C. §121 applies that prohibition against the patent, or application itself, and that prohibition is not limited by either the style, format or even the content of the claims in the divisional application. Moreover, what the Examiner appears to have ignored here is that a requirement for restriction is imposed on the basis of **subject matter**, not upon either the text of the claims themselves, or upon whether the pending claims are drafted as an “**apparatus**” or a “**method**” format because the claims define neither a Group in a requirement for restriction or a Genius or Species in a requirement for an election of species.

This point is emphatically illustrated by the Federal Circuit in *TiVo, Inc. v. Echostar Communications Corporation, et al.*, which ruled that “**hardware claims**” may be written in both a “**process**” style (e.g. claim 1 in *TiVo*) and in an “**apparatus**” style (e.g. claim 32 in *TiVo*). Consequently, the claims presented in a divisional application that are directed to the **non-elected subject matter** of Group II defined in Paper No. 4 may be written either in an “**apparatus**” style or in a “**process**” style.

The pending claims such as claim 59 and its dependent claims 60 through 64 that define the cooperative relation between the “control panel” and Appellant’s “first unit”, “second unit”, “third unit”, “common gas system”, “mode select switch” and the “first compressor” and the “second compressor.” The particular operational relationships between the structural features of claim 59 define the “method of operating a gas system and method of testing” of non-elected Group II (e.g., “compressing the air when the pressure ... is below ...” and “compressing the air when the pressure ... is equal to ...”) of Paper No. 4. Consequently, the prohibition of 35 U.S.C. §121 prohibits the citation of the parent to which the requirement for restriction was applied, to support a double patenting rejection of claims 59 in the instant divisional application. The Examiner is accordingly urged to reconsider and withdraw rejection.

In summary, the admonition of the Commissioner written about 35 U.S.C. §121 (in all capital letters) in *MPEP* §803.01,

“IT STILL REMAINS IMPORTANT FROM THE

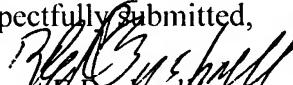
STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.”

In other words, assuming an applicant who sought after imposition of a requirement for restriction, seeks “two patents for the same invention,” the Commissioner’s admonition makes clear that there is nothing in 35 U.S.C. §121 that authorizes any member of the Examining Corps in the U.S. PTO to forbid the issuance of those “two patents for the same invention.”

Applicant’s undersigned attorney respectfully submits however, that the methodology of inventors and applicants do not work this way, but rather always seek patent protection upon improvements upon their improvements.

The Examiner is respectfully invited to ponder therefore, that in light of the Commissioner’s explicit caution, delivered in all capital letters in *MPEP* §803.01, that Paper No. 20091022 is mere Examiner’s argument devoid of authority of either 37 CFR or judicial decision.

It is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant’s attorney.

Respectfully submitted,

/Robert E. Bushnell
Robert E. Bushnell,
Registration No.: 27,774

Customer No. 008439
2029 "K" Street N.W., Suite 600
Washington, D.C. 20006-1004
(202) 408-9040

Folio: P56713US
Date: 1/26/10
I.D.: REB/kf